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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,060	12/04/2003	Kelly Tidwell	5983P002	7669

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EXAMINER

KIM, SUN U

ART UNIT	PAPER NUMBER
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1797

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/728,060	Applicant(s) TIDWELL, KELLY	
	Examiner John Kim	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2007 and 31 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/28/07 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/31/07</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/28/07 has been entered.

This Office Action is in response to the Amendment filed on February 28, 2007.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 41 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 41 and 53 are indefinite for failing to particularly point out that each inlet positioned substantially over the upper cup like member and a filter element rather than the entire filter cartridge. Recitation of "said filter cartridge" in claims 41 and 53 only provides an antecedent basis for a whole reusable filter and not a filter element.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 41-42, 45-46, 53 and 56-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (U.S. Patent No. 5,569,373) in view of Hultgren (U.S. Patent No. 3,315,809). Regarding Claims 41-42 and 53, Smith et al disclose a reusable oil filter comprising a can like housing (10) having a closed bottom and an inside surface with internal threads (108),

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a filter cartridge having an upper and lower filter rings (65, 67) and a woven metal mesh filter element (64, 66), and a cap (14) having an internally threaded central hub (54) and at least two oil distribution channels (46) having an inlet and an outlet, each inlet positioned substantially over the upper filter ring (65, 67) and filter cap (82), each outlet positioned outside the upper filter ring (65, 67) and filter cap (82), each oil distribution channel (46) extending continuously downwardly and radially outwardly to distribute oil to the inside surface of the can like housing (10), the cap (14) threadably connected to the can like housing (10) to clamp the filter cartridge between the cap (14) and the closed bottom (see figure 2; col. 3, line 41 – col. 6, line 54).

However, Smith et al do not teach the filter cartridge having an upper cup like member and a lower cup like member. Hultgren teaches an oil filter comprising a filter cartridge comprising filter element sealed off by incaps (40, 42) i.e. an upper cup like member and a lower cup like member (see figure 1; col. 3, lines 22-29). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the filter cartridge of Smith et al to incorporate incaps to maintain the filter element in a seated position in the filter housing as suggested by Hultgren (see col. 3, lines 25-29).

Regarding Claims 45 and 56, Smith et al teach a seal ring (38.1) positioned outside the inlets (46) (see figure 2; col. 3, lines 41-51).

Regarding claim 46 and 57, Smith et al teach an O-ring seal (57) between the cap (14) and the filter cap member (72) (see figure 2; col. 4, lines 16-26).

Regarding Claims 48 and 58, Smith et al teach an O-ring seal (60) between the cap (14) and the can like housing (10) (see figure 2; col. 4, lines 28-34).

Regarding Claims 49 and 59, Smith et al teach a raised center section (88) on the closed bottom of the can like housing (10) (see figure 2).

Regarding claims 50 and 60, Smith et al teach a bypass valve (86) being clamped between the filter cartridge and the closed bottom (see figure 2; col. 5, line 66 – col. 7, line 33).

Regarding claims 51 and 61, Smith et al teach an internally and externally threaded insert fitting (16) within the internally threaded central hub (54)(see figure 2; col. 3, lines 6-57).

Regarding claims 52 and 62, Smith et al teach openings (46) collectively occupying most of an opening area and distributed around the internally threaded central hub (54) (see figures 2, 4; col. 3, line 59 – col. 4, line 14). Smith et al do not teach the annular arc segment openings. Hultgren teaches an oil filter comprising arc segment shaped openings providing restriction of oil to an absolute minimum (Col. 4, lines 3-33). It would have been obvious to one of ordinary skill in the art to modify the shape of the openings of Smith et al with the annular arc segment openings to minimize restriction of oil flow as suggested by Hultgren (Col. 4, lines 24-33).

6. Claims 43 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al in view of Hultgren as applied to Claims 42 and 53 above, and further in view of Cox (U.S. Patent No. 5,888,383).

Regarding Claims 43 and 55, Smith et al teaches a woven metal mesh filter but does not teach a pleated filter. Cox teaches an oil filter comprising a pleated wire mesh filter (30) (see figure 3; col. 5, lines 32-34). It would have been obvious to one of ordinary skill in the art to modify the tubular woven wire mesh filter element of Smith et al in view of Hultgren with known pleated woven metal filter element of Cox because the configuration of the filter element is a matter of choice which a person of ordinary skill in the art would have found obvious absent

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persuasive evidence that the particular configuration of the claimed filter is significant. See *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) and MPEP 2144.04 IV. B.

7. Claims 44 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al in view of Hultgren as applied to Claims 42 and 53 above, and further in view of Deibel et al. (U.S. Patent No. 6,221,242 B1).

Regarding Claims 44 and 54, Smith et al in view of Hultgren does not disclose the material of the filter element. Deibel et al teach a stainless steel woven metal filter element (Col. 6, Lines 34-37). It would have been obvious to one of ordinary skill in the art to modify the tubular woven wire mesh filter element of Smith et al in view of Hultgren with known stainless steel tubular woven metal filter element of Deibel et al because they are reusable oil filters and because it is a material of manufacture common in the filter art.

8. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al in view of Hultgren as applied to Claim 42 above, and further in view of Tettman et al. (U.S. Patent No. 5,679,244).

Regarding claim 47, Smith et al teach that a seal is formed between the lower filter ring (65, 67) and a shoulder (92) of the support plate (88) from a closed bottom (see col. 5, line 66 – col. 6, line 10) but does not disclose an O-ring seal between the lower cup like member and the closed bottom. Tettman et al teach an oil filter comprising an O-ring (Fig. 4, #44) at the end of the filter element against a bottom surface of the can-like body. It would have been obvious to one of ordinary skill in the art to modify the reusable filter of Smith et al in view of Hultgren with provision of an O-ring at the other end of the filter element against a bottom surface of the

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can-like body in order to prevent liquid from traveling through the housing without passing through the filter media as suggested by Tettman et al (Col. 2, Lines 58-60).

9. Claims 42-43, 45-46, 48-49 and 51-52 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 53, 55-59 and 61-62 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

10. Applicant's arguments filed 9/28/07 have been fully considered but they are not persuasive.

11. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is 571-272-1142. The examiner can normally be reached on Monday-Friday 7 a.m. - 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/John Kim/
Primary Examiner
Art Unit 1797**

JK
1/4/08